UNITED STATES PATENT AND TRADEMARK OFFICE

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

PTOL-90A (Rev. 04/07)

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>20 September 2006</u>.

2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>10-18</u> is/are pending in the application.

    4a) Of the above claim(s) <u>1-9</u> is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>10-18</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All   b) ☐ Some * c) ☐ None of:

        1. ☒ Certified copies of the priority documents have been received.

        2. ☐ Certified copies of the priority documents have been received in Application No. _____.

        3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>9/20/2006</u>.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

1.   This Office Action in response to the Application no. 10593477 filed on 9/26/2006

is entered.

Claims 1 – 9 have been canceled and 10 – 18 have been newly added based on

Preliminary Amendment filed on 9/20/2006.

Claims 10 – 18 are hence entered and presented for examination.

Priority

2.   Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which

papers have been placed of record in the file.

Information Disclosure Statement

3.   The information disclosure statement (IDS) submitted on 9/20/2006 was filed,

and the submission is in compliance with the provisions of 37 CFR 1.97. Accordingly,

the information disclosure statement is being considered by the examiner.

Claim Objections

4.   Claims 10, 11, 12, 13, 14, 15, 16, 17, 18 are objected to because of the following

informalities:

Regarding claim 10, the clause "operable to" in lines 3, 8, 11, 15, 18, respectively

is not a positive recitation. Appropriate correction is required.

Regarding claim 11, the clause "operable to" in line 2 is not a positive recitation.

Appropriate correction is required.

Regarding claim 12, the clause "operable to" in lines 2, 5, respectively is not a

positive recitation. Appropriate correction is required.

Regarding claim 13, the clause "operable to" in lines 2, 5, respectively is not a positive recitation. Appropriate correction is required.

Regarding claim 14, the clause "operable to" in lines 4, 7, 8, 9, 12, 14, 16, 20, 22, respectively is not a positive recitation. Appropriate correction is required.

Regarding claim 15, the clause "operable to" in line 2 is not a positive recitation. Appropriate correction is required.

Regarding claim 16, the clause "operable to" in lines 3, 7, respectively is not a positive recitation. Appropriate correction is required.

Regarding claim 17, the clause "operable to" in lines 2, 5, respectively is not a positive recitation. Appropriate correction is required.

Regarding claim 18, the clause "operable to" in line 2 is not a positive recitation. Appropriate correction is required.

Claim Rejections - 35 USC § 101

5.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6.   Claim 18 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Regarding claim 18, the claim is merely a program claim, per se. Since computer programs claimed as computer listings per se, i.e., the descriptions or expressions of the programs, are not physical "things." They are neither computer components nor statutory processes, as they are not "acts" being performed. Such claimed computer programs do not define any structural and functional

interrelationships between the computer program and other claimed elements of a

computer which permit the computer program's functionality to be realized. Besides, the

claimed subject matter "a program" is not claimed as embodied in computer-readable

media are descriptive material per se and are not statutory because they are not

capable of causing functional change in the computer. See, e.g., Warmerdam, 33 F.3d

at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory). *See*

MPEP § 2106.

Claim Rejections - 35 USC § 103

7.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

8.   Claims 10 – 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Kawakami et al. (US 20020198780 A1) in view of Soga et al. (US 7386311 B2).

Regarding claims 10, 17, Kawakami et al. disclose a content relay server, and a

method for relaying a content between a content source apparatus and a content

destination apparatus *(Abstract, Fig.1, Fig. 5),* said content relay server*(element 10, Fig.*

1, element 10a, Fig. 5) comprising: an information storing unit operable to store

identification information of the content destination apparatus and content information

about a content that can be received by the content destination apparatus, the

identification information and content information being associated with each other, and

operable to store source information about the content source apparatus and

destination information about the content destination apparatus *(element 12,*

*advertisement content storing section, Fig. 1, paras. [0013], [0029],[0045]);*a content

receiving unit operable to receive, from the content source apparatus, identification

information of the content destination apparatus, a content associated with the

identification information, and source information about the content source apparatus

(element 14 receiving section, Fig. 1, paras. [0042], [0043]); a transfer judging unit

operable to extract, from said information storing unit, content information associated

with the received identification information of the content destination apparatus, and

judge, based on the content information, whether or not the received content can be

received by the content destination apparatus *(element 13, Judgment Section, Fig. 1,*

para. [0045], [0046]); a content transferring unit operable to transfer the received

content to the content destination apparatus identified by the identification information

when said transfer judging unit judges that the content can be received *(element 16,*

transmitting section, Fig. 1, para. [0042], [0046]); and Kawakami et al. disclose implicitly

a transfer rejection notifying unit operable to provide notice of a transfer rejection to at

least one of a message displaying apparatus and a destination displaying apparatus

when said transfer judging unit judges that the content cannot be received *(element 11,*

scheduler, paras. [0042], [0046], [0047]).

Kawakami et al. do not disclose explicitly a transfer rejection notifying unit

operable to provide notice of a transfer rejection to at least one of a message displaying

apparatus and a destination displaying apparatus when said transfer judging unit judges

that the content cannot be received.

Soga et al. in the same field of endeavor teach a transfer rejection notifying unit operable to provide notice of a transfer rejection to at least one of a message displaying apparatus and a destination displaying apparatus when said transfer judging unit judges that the content cannot be received *(Fig. 2, col. 2, lines 46 – 51, col. 3, lines 20 – 26, col. 8, lines 3 – 12).*

At time the invention was made it would have been obvious to a person of ordinary skill in the art to modify the teachings of Kawakami et al. to include the features of a transfer rejection notifying unit operable to provide notice of a transfer rejection to at least one of a message displaying apparatus and a destination displaying apparatus when said transfer judging unit judges that the content cannot be received as taught by Soga et al. One of ordinary skill in the art would be motivated to do so for providing a system which is able to carry out an appropriate service when transmitting contents by using a roaming service by taking into account circumstances of a country or a region where the mobile unit to which contents are transmitted is in, or circumstances of the mobile communication network the mobile unit to which contents are transmitted belongs to *(as suggested by Soga et al., see col. 2, lines 21 – 27).*

Regarding claim 11, Kawakami et al. disclose the content relay server claimed further comprising an arrival advance notifying unit operable to provide advance notice to the content destination apparatus based on destination information when said transfer judging unit judges that the content cannot be received, the advance notice

indicating that the content has arrived at said content relay server but cannot be transferred to the content destination apparatus *(paras [0042], [0045], [0046]).*

Regarding claim 12, Kawakami et al. do not disclose wherein said information storing unit is operable to store rejection information for rejecting a reception of a content transmitted from a specific source; and said content relay server further comprises a reception rejecting unit operable to judge whether or not the source information transmitted from the content source apparatus is included in the rejection information, and reject a reception of the content and provide notice of the reception rejection to the content source apparatus when the source information is included.

Soga et al. in the same field of endeavor teach wherein said information storing unit is operable to store rejection information for rejecting a reception of a content transmitted from a specific source; and said content relay server further comprises a reception rejecting unit operable to judge whether or not the source information transmitted from the content source apparatus is included in the rejection information, and reject a reception of the content and provide notice of the reception rejection to the content source apparatus when the source information is included *("access rejection function"; Fig. 2, col. 2, lines 46 – 51, col. 3, lines 20 – 26, col. 8, lines 3 – 12, col. 12, lines 1 – 15).*

At time the invention was made it would have been obvious to a person of ordinary skill in the art to modify the teachings of Kawakami et al. to include the features of wherein said information storing unit is operable to store rejection information for

rejecting a reception of a content transmitted from a specific source; and said content

relay server further comprises a reception rejecting unit operable to judge whether or

not the source information transmitted from the content source apparatus is included in

the rejection information, and reject a reception of the content and provide notice of the

reception rejection to the content source apparatus when the source information is

included as taught by Soga et al. One of ordinary skill in the art would be motivated to

do so for providing a system which is able to carry out an appropriate service when

transmitting contents by using a roaming service by taking into account circumstances

of a country or a region where the mobile unit to which contents are transmitted is in, or

circumstances of the mobile communication network the mobile unit to which contents

are transmitted belongs to *(as suggested by Soga et al., see col. 2, lines 21 – 27).*

Regarding claim 13, Kawakami et al. do not disclose explicitly wherein said

information storing unit is operable to store rejection information for rejecting a reception

of a content transmitted from a specific source; and said content relay server further

comprises a reception rejecting unit operable to judge whether or not the source

information transmitted from the content source apparatus is included in the rejection

information, and reject a reception of the content.

Soga et al. in the same field of endeavor teach wherein said information storing

unit is operable to store rejection information for rejecting a reception of a content

transmitted from a specific source *("storage means"; col. 3, lines 17 – 26, col. 8, lines 3

– 12);* and said content relay server further comprises a reception rejecting unit

operable to judge whether or not the source information transmitted from the content

source apparatus is included in the rejection information, and reject a reception of the

content *("access rejection function"; Fig. 2, col. 2, lines 46 – 51, col. 3, lines 20 – 26,*

col. 8, lines 3 – 12, col. 12, lines 1 – 15).

At time the invention was made it would have been obvious to a person of

ordinary skill in the art to modify the teachings of Kawakami et al. to include the features

of wherein said information storing unit is operable to store rejection information for

rejecting a reception of a content transmitted from a specific source; and said content

relay server further comprises a reception rejecting unit operable to judge whether or

not the source information transmitted from the content source apparatus is included in

the rejection information, and reject a reception of the content as taught by Soga et al.

One of ordinary skill in the art would be motivated to do so for providing a system which

is able to carry out an appropriate service when transmitting contents by using a

roaming service by taking into account circumstances of a country or a region where the

mobile unit to which contents are transmitted is in, or circumstances of the mobile

communication network the mobile unit to which contents are transmitted belongs to *(as*

suggested by Soga et al., see col. 2, lines 21 – 27).

Regarding claim 14, Kawakami et al. disclose a content relay system for

transmitting and receiving a content via a content relay server *(Fig. 1, Fig. 5),* said

content relay system comprising: a content transmitting apparatus having unique

identification information and being operable to transmit a content *(elements 20, 22,*

"content server", transmitting section"'; Fig. 1, para. [0039]); a message displaying

apparatus which is given an address associated with said content transmitting

apparatus *("display banner advertisements"; para. [0009])*; a content storing apparatus

operable to store a content *(elements 20, 21, "content server and image content storing*

section"; Fig. 1, para. [0039]); and a content relay server operable to relay a content

server*(element 10, Fig. 1, element 10a, Fig. 5)*, said content relay server comprising: an

information storing unit operable to store identification information of a content

destination apparatus and content information about a content that can be received by

the content destination apparatus, the identification information and content information

being associated with each other, and operable to store source information about a

content source apparatus and destination information about the content destination

apparatus (*(element 12, advertisement content storing section, Fig. 1, paras. [0013],*

[0029],[0045]); a content receiving unit operable to receive, from the content source

apparatus, identification information of the content destination apparatus, a content

associated with the identification information, and source information about the content

source apparatus *element 14 receiving section, Fig. 1, paras. [0042], [0043])*;; a transfer

judging unit operable to extract, from said information storing unit, content information

associated with the received identification information of the content destination

apparatus, and judge, based on the content information, whether or not the received

content can be received by the content destination apparatus *(element 13, Judgment*

Section, Fig. 1, para. [0045], [0046]);; a content transferring unit operable to transfer the

received content to the content destination apparatus identified by the identification

information when said transfer judging unit judges that the content can be received

element 16, transmitting section, Fig. 1, para. [0042], [0046]); and Kawakami et al.

disclose implicitly a transfer rejection notifying unit operable to provide notice of a

transfer rejection to the content source apparatus based on the source information

when said transfer judging unit judges that the content cannot be received *(element 11,*

scheduler, paras. [0042], [0046], [0047]).

Kawakami et al. do not disclose explicitly a transfer rejection notifying unit

operable to provide notice of a transfer rejection to the content source apparatus based

on the source information when said transfer judging unit judges that the content cannot

be received.

Soga et al. in the same field of endeavor teach a transfer rejection notifying unit

operable to provide notice of a transfer rejection to the content source apparatus based

on the source information when said transfer judging unit judges that the content cannot

be received *(Fig. 2, col. 2, lines 46 – 51, col. 3, lines 20 – 26, col. 8, lines 3 – 12)*.

At time the invention was made it would have been obvious to a person of

ordinary skill in the art to modify the teachings of Kawakami et al. to include the features

of a transfer rejection notifying unit operable to provide notice of a transfer rejection to

the content source apparatus based on the source information when said transfer

judging unit judges that the content cannot be received as taught by Soga et al. One of

ordinary skill in the art would be motivated to do so for providing a system which is able

to carry out an appropriate service when transmitting contents by using a roaming

service by taking into account circumstances of a country or a region where the mobile

unit to which contents are transmitted is in, or circumstances of the mobile

communication network the mobile unit to which contents are transmitted belongs to *(as*

suggested by Soga et al., see col. 2, lines 21 – 27).

Regarding claim 15, Kawakami et al. disclose the content relay system claimed

further comprising a destination displaying apparatus operable to receive advance

notice of a content arrival and display a message indicating the advance notice *(paras*

[0042], [0045]-[0047]).

Regarding claim 16, Kawakami et al. disclose the content relay system claimed

wherein said the content storing apparatus *(Fig. 1)* except comprises a content

information update requesting unit operable to provide notice of a change in the content

information to said content relay server when the content information about the content

that can be received has been changed; and said content relay server further comprises

an information updating unit operable to update the content information stored in said

information storing unit upon request from said content information update requesting

unit.

Soga et al. in the same field of endeavor teach a content information update

requesting unit operable to provide notice of a change in the content information to said

content relay server when the content information about the content that can be

received has been changed *(col. 10, lines 30 – 38)*; and said content relay server further

comprises an information updating unit operable to update the content information

stored in said information storing unit upon request from said content information update

requesting unit *(Fig. 2, col. 2, lines 46 – 51, col. 3, lines 20 – 26, col. 8, lines 3 – 12, col.*

10, lines 39 – 64).

      At time the invention was made it would have been obvious to a person of

ordinary skill in the art to modify the teachings of Kawakami et al. to include the features

of a content information update requesting unit operable to provide notice of a change in

the content information to said content relay server when the content information about

the content that can be received has been changed; and said content relay server

further comprises an information updating unit operable to update the content

information stored in said information storing unit upon request from said content

information update requesting unit as taught by Soga et al. One of ordinary skill in the

art would be motivated to do so for providing a system which is able to carry out an

appropriate service when transmitting contents by using a roaming service by taking

into account circumstances of a country or a region where the mobile unit to which

contents are transmitted is in, or circumstances of the mobile communication network

the mobile unit to which contents are transmitted belongs to *(as suggested by Soga et*

al., see col. 2, lines 21 – 27).

      Regarding claim 18, Kawakami et al. disclose a program for relaying a content

between a content source apparatus and a content destination apparatus *("content*

distribution program"; para. [0107]), said program comprising executable code operable

to cause a computer to perform: receiving, from the content source apparatus,

identification information of the content destination apparatus, a content associated with the identification information, and source information about the content source apparatus (Fig. 1 *(element 14 receiving section, Fig. 1, paras. [0042])*; extracting, from the information storing unit, content information associated with the received identification information of the content destination apparatus, and judging, based on the content information, whether or not the received content can be received by the content destination apparatus (*(element 13, Judgment Section, Fig. 1, para. [0045], [0046]*); transferring the received content to the content destination apparatus identified by the identification information when it is judged that the content can be received *(element 16, transmitting section, Fig. 1, para. [0042], [0046])*; and providing notice of a transfer rejection to the content source apparatus based on the source information when it is judged that the content cannot be received *(element 16, transmitting section, Fig. 1, para. [0042], [0046])*.

Kawakami et al. do not disclose explicitly a transfer rejection notifying unit operable to provide notice of a transfer rejection to at least one of a message displaying apparatus and a destination displaying apparatus when said transfer judging unit judges that the content cannot be received.

Soga et al. in the same field of endeavor teach a transfer rejection notifying unit operable to provide notice of a transfer rejection to at least one of a message displaying apparatus and a destination displaying apparatus when said transfer judging unit judges that the content cannot be received *(Fig. 2, col. 2, lines 46 – 51, col. 3, lines 20 – 26, col. 8, lines 3 – 12)*.

At time the invention was made it would have been obvious to a person of

ordinary skill in the art to modify the teachings of Kawakami et al. to include the features

of a transfer rejection notifying unit operable to provide notice of a transfer rejection to at

least one of a message displaying apparatus and a destination displaying apparatus

when said transfer judging unit judges that the content cannot be received as taught by

Soga et al. One of ordinary skill in the art would be motivated to do so for providing a

system which is able to carry out an appropriate service when transmitting contents by

using a roaming service by taking into account circumstances of a country or a region

where the mobile unit to which contents are transmitted is in, or circumstances of the

mobile communication network the mobile unit to which contents are transmitted

belongs to *(as suggested by Soga et al., see col. 2, lines 21 – 27).*

Conclusion

9.   The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure.

a) Yamaguchi (US 7031654 B2) teaches repeater, mobile radio communication
    system, fault notification method for said repeater or said mobile radio
    communication system, and recording medium having, recorded thereon,
    fault notification program for said repeater or said mobile radio
    communication system.

b) Kobayashi (US 7222186 B2) teaches content transferring technique.

c) Takeshima et al. (US 20040054779 A1) teach network system.

10.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Andrew C. Lee whose telephone number is (571)272-

3131. The examiner can normally be reached on Monday through Friday from 8:30am - 5:00pm.

      If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edan Orgad can be reached on (571) 272-7884. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

      Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Andrew C Lee/
Examiner, Art Unit 2419
<2/21/2009:2Qy09>

/Edan Orgad/
Supervisory Patent Examiner, Art Unit 2419